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10/511,223

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Georg Gros

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24972 7590 11/28/2008  
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EXAMINER

VIJAYAKUMAR, KALLAMBELLA M

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/511,223	<b>Applicant(s)</b> GROS, GEORG	
	<b>Examiner</b> KALLAMBELLA VIJAYAKUMAR	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 141-177 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 141-177 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

- Applicants amendment filed 08/14/2008 has been entered. Claims 104-140 cancelled. New Claims 141-177 were added. Claims 141-177 as amended are currently pending with the application. Original claim-104 was amended as current claim 141.
- Applicants amendment overcomes the objection to claims, and rejection of claim- 104 under 35 USC I-Para and rejection of claims 119 and 121-122 under 35 USC 112-II Para cited in the last office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 141-177 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim-141 recites a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore

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not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 104 recites the broad recitation 0.5-70 wt% of A in D). , and the claim also recites 4.5-70 wt% in A). which is the narrower statement of the range/limitation. Claims 142-177 are rejected are rejected as dependent upon a rejected base claim-141.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 141-154, 156-171, 173-177 are rejected under 35 U.S.C. 103(a) as obvious over Leon et al (US 3,562,124) in view of either Tsuneta (US 5,213,846) or Matsuda et al (US 3,904,555) .

The examiner makes of record that instant claim 141 recites a broad range of components (A is from 0.5-70 wt% of the mixture) followed by a series of narrow ranges (A is present in an

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amount of from 4.5 to 60 wt% of the mixture). For examination purposes, the examiner asserts that the narrow ranges recited in instant claim-141 are merely exemplary ranges, and thus, the prior art will be applied against the broadest ranges recited in instant claim 141.

The examiner makes of record that in Claim-141, component-A is at least one conductive/semiconductive element or compound selected from a, b, or c, wherein the mixture comprises at least 4.5-60 wt% by weight of “a”, and A is present in an amount of 0.5-70 wt% of the mixture whereby the components b, c, and d are optional components, and Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure [MPEP 2111.04 [R-3]].

Leon et al teach the corrosion protection coating liquid comprising an 3-50 wt% organic binder such as an epoxy (Cl-5, Ln 21-25; Cl-2, Ln 35-44) and 20-95 wt% of a filler comprising conductive metal particles such as **zinc**, **aluminum** or **magnesium** (Cl-2, Ln 54-59; Cl-3, Ln 17-28). 10-85 wt% of the filler contained comminuted ferro alloy such as **ferromolybdenum** and **ferrotungsten** (Cl-3, Ln 13-16; 33-36). The coating composition contained 5-60 wt% solvents, and up to 70 wt% of curing agent, and plasticizers such as castor oil or chlorinated paraffin (Cl-4, Ln 43-66). The component ratios overlap with the instant claimed ranges in the claims. The prior art further teaches the addition of magnesium montmorillonite, a silicate based additive in the coating composition (Cl-5, Ex-1, Ln 67). The particle size of the conductive fillers was 1-5 micron for the ferro alloys (Cl-3, Ln 67-70). The prior art further teaches coating a metallic substrate such as ferrous metals and forming films in the range of about 0.5-5.0 mils (Cl-5, Ln 2-8).

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The prior art fails to teach the instant claimed Sn or Sn alloy per claim 141, particle sizes in claim 147, a film thickness of not more than 6 micron per claims 154, 161 or 177; or the particle size of Mg-morrillonite <silicate based pigment> per claims 171 and 174-175.

In the analogous art, Matsuda et al teach weldable/corrosion-resistant paint composition comprising one or more hard metals selected from Fe, Ni, Co, Cr, Mn and their alloys, one or more soft metals selected from Al, Zn, Pb, Cu, Cd, Mg, Ag, Sn and their alloys (Abstract, Cl-1, Ln 55-63; Cl-3, Ln 1-2), a resin such as epoxy or acrylic dispersed and a solvent (Cl-3, Ln 10-17); and coating galvanized steel plate with the composition (Cl-3, Ln 22-26) with improved electroresistance weldability in spite of low metal content and corrosion resistance (Cl-2, Ln 31-33; 42-45; Cl-3, Ln 27-28).

In the analogous art, Tsuneta et al teach corrosion-resistant paint composition comprising a binder such as epoxy, silicate such as silica, graphite and a conductive metal powder selected from Zn, Al, Mg, Fe Ni, Co, Sn, Cu, Cr, Mn or an alloy thereof (Abstract, Cl-5, Ln 1-25) and coating steel plate (Cl-6, Ln 9-11) with improved weldability (Cl-5, Ln 18-22).

It would have been obvious to a person of ordinary skilled in the art to either include or substitute the conductive metal powder in the composition of Leon et al with Sn or its alloy of either Matsuda or Tsuneta et al as functional equivalent to benefit from improved corrosion-resistance/weldability with predictable results and reasonable expectation of success, because the teachings are in the analogous art of weldable/corrosion-resistance coatings for metals and the species of Leon's conductive metal fillers are encompassed by the genus of conductive fillers containing Sn and its alloys.

With regard to claims 148 and 176, the prior art teaches ferrotungsten.

With regard to the particle sizes in claims 143-146, the prior art particle sizes of the ferro fillers overlap over the instant claimed ranges, and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

With regard to the particle sizes in claim-147, the prior art teaches varying the particle size wherein it would have been obvious to a person of ordinary skilled in the art to optimize the particle size by routine experimentation, and Generally, differences in concentration or temperature or particle size will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature or particle size is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With regard to claim-149, the prior art teaches a composition comprising epoxy binder.

With regard to claim 150, the prior art teaches ferromolybdenum.

With regard to claims 151-152, they are not essential components of the composition as shown by the lower limit of 4.5 wt% for a and A, and Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure [MPEP 2111.04 [R-3]].

With regard to claim-153, the range of not more than 1.5 wt% wax includes 0.0% and makes the component optional.

With regard to the claims 154, 161 and 177, the prior art teaches coating a metallic substrate with the composition and varying the thickness of the coated film and further suggestive that the thickness outside the typical range of 0.5 to 5.0 mil could be used depending upon the particular conditions of application and intended use, and it would have been obvious to a person of ordinary skilled in the art to optimize the coating thickness as a choice of design of intended application with reasonable expectation of success. Generally, differences in concentration or temperature or thickness will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature or thickness is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With regard to the process steps in claims 156, 158 and 160, the prior art teaches grinding and mixing the components forming a coating liquid, and coating a steel substrate forming a protective layer over the substrate (Cl-3, Ln 72 – Cl-4, Ln 41), and the examiner asserts that the prior art coating will be either same or substantially same as that produced by the claimed process steps.

With regard to claims 157 and 159, the particle size of particles being no greater than the thickness of the coating would be obvious over the coating thickness and particle size of fillers.

With regard to claims 162 and 167, the prior art does not add either organic lubricants or PTFE.

With regard to claims 163-166 and 168, the prior art teaches coating ferrous metals. Further, with regard to product by process limitation in claims 165-166, the prior art product is



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either same or substantially same as that claimed by the applicants and When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process, the claim is not patentable. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) And *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP §2113.

With regard to claims 169 and 170, the combined prior art teaches Sn and Sn alloy fillers.

With regard to claims 171 and 174-175, the prior art teaches composition containing magnesium montmorillonite, and using conductive fillers with a particle size of 1-5 micron and forming coated layers over the substrate that is as low as 12.7 micron, and the claimed upper limit of 5/6 micron for the Mg-montmorillonite would have been obvious in the prior art composition. The prior art further teaches addition of curing agents such as polyamines and polyamides (Cl-4, Ln 51-56).

With regard to claim 173, the prior art component range overlaps with the instant claimed range and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

2. Claims 141-177 are rejected under 35 U.S.C. 103(a) as being obvious over Reising et al (US 6,715,916) in view of either Tsuneta (US 5,213,846) or Matsuda et al (US 3,904,555).

Reising et al teach a coating composition for weldable substrates comprising one or more conductive pigments comprising Al, Zn, **W**, **Graphite** and ferrophos (A/a) with a particle size of ~1 to ~5 microns, preferably ~ 3 micron, and in the amount of ~30 to ~60 by volume % that will

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meet the component ratio when calculated in terms of wt%. Graphite makes the conductive particles sliding because of its layered structure. The binder comprised of resins such as epoxy or polyurethane in the amount of ~10 to ~20 wt% (Cl-6, Ln 1-17). The composition further contained crosslinkers such as cymel and/or blocked isocyanates and a solvent and the pigment to binder ratio was ~10 to ~50 wt% (Cl-6, Ln 34-64; Cl-9, Ln 43-48) that meets the ratio limitations in claim-141 and size limitations in claims 142-146. The coating composition further contains hydrogenated or sulfated castor oil and pigments such as magnesium silicate (Cl-7, Ln 4-11). The prior art does not teach the addition of organic lubricants or PTFE that meets the limitation of claims 162 and 167. With regard to claims 171-173 and 176-177, the prior art teaches the composition containing blocked isocyanates, urea-melamine derivatives and tungsten and coating the film over a metal substrate (Cl-5, Ln 45; Cl-6, Ln 39-41; Cl-8, Ln 4-7; Cl-9, Ln 44-49).

The prior art fails to teach the instant claimed Sn or Sn alloy per claim 141, particle sizes in claim 147, and silent about the amount of castor oil derivative added per claim 153 and particle size of Magnesium silicate per claims 171 and 174-175.

In the analogous art, Matsuda et al teach weldable/corrosion-resistant paint composition comprising one or more hard metals selected from Fe, Ni, Co, Cr, Mn and their alloys, one or more soft metals selected from Al, Zn, Pb, Cu, Cd, Mg, Ag, Sn and their alloys (Abstract, Cl-1, Ln 55-63; Cl-3, Ln 1-2), a resin such as epoxy or acrylic dispersed and a solvent (Cl-3, Ln 10-17); and coating galvanized steel plate with the composition (Cl-3, Ln 22-26) with improved electroresistance weldability in spite of low metal content and corrosion resistance (Cl-2, Ln 31-33; 42-45; Cl-3, Ln 27-28).

In the analogous art, Tsuneta et al teach corrosion-resistant paint composition comprising a binder such as epoxy, silicate such as silica, graphite and a conductive metal powder selected from Zn, Al, Mg, Fe Ni, Co, Sn, Cu, Cr, Mn or an alloy thereof (Abstract, Cl-5, Ln 1-25) and coating steel plate (Cl-6, Ln 9-11) with improved weldability (Cl-5, Ln 18-22).

It would have been obvious to a person of ordinary skilled in the art to either include or substitute the conductive metal powder in the composition of Reising et al with Sn or its alloy of either Matsuda or Tsuneta et al as functional equivalent to benefit from improved corrosion-resistance/weldability with predictable results and reasonable expectation of success, because the teachings are in the analogous art of weldable/corrosion-resistance coatings for metals and the species of Leon's conductive metal fillers are encompassed by the genus of conductive fillers containing Sn and its alloys.

With regard to claims 148 and 176, the prior art teaches tungsten.

With regard to the particle sizes in claims 143-146, the prior art particle sizes of ~1 to ~5 microns for conductive fillers that overlap over the instant claimed ranges, and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

With regard to the particle sizes in claim-147, the prior art teaches varying the particle size wherein it would have been obvious to a person of ordinary skilled in the art to optimize the particle size by routine experimentation, and Generally, differences in concentration or temperature or particle size will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature or particle size

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is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With regard to claim-149, the prior art teaches a composition comprising epoxy binder.

With regard to claim-150, the prior art teaches a composition comprising zinc molybdate (Cl-7, Ln 13-15).

With regard to claims 151-152, they are not essential components of the composition as shown by the lower limit of 4.5 wt% for a and A, and Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure [MPEP 2111.04 [R-3]].

With regard to claim-153, the prior art teaches the addition of castor oil derivative and any trivial amount of the component would meet the limitation of not more than 1.5 wt% ( $0 \leq x \leq 1.5$ , x=amt. added) in claim 141.

With regard to process claims 154-168 and 177, the prior art teaches forming the coating composition by milling the components (Cl-13, Ln 19-27) and applying the coating over the substrates such as steel by degreasing the substrate with a degreaser, optionally applying a pretreatment, coating the composition and curing at a temperature up to ~ 300C peak metal forming a coating with a thickness of 3-8 micron (Cl-4, Ln 22-30, 53-65, Cl-5, Ln 10-20; Cl-7, Ln 32-47; Cl-8, Ln 4-7). With regard to claims 156 and 158, the prior art teaches milling the components. With regard to claims 157 and 159, the particle size of particles being no greater than the thickness of the coating would be obvious over the film thickness and particle size of conductive fillers. With regard to claims 162 and 167, the composition is free of organic

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lubricants and arsenic. With regard to claims 163-166 and 168, the prior art teaches coating ferrous metals (Cl-16, Claim-16). Further, with regard to product by process limitation in claims 165-166, the prior art product is either same or substantially same as that claimed by the applicants and When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process, the claim is not patentable. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) And *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP §2113. With regard to the film thickness in claims 117, 124 and 140, the prior art thickness of 3-8 micron overlaps with the instant claimed range of not more than 6 micron and prima-facie obviousness exists.

With regard to claims 169-170, the combined prior art teaches Sn and Sn alloy fillers.

With regard to claims 171-172 and 174-175, the prior art teaches Mg-silicate and blocked isocyanate. With regard to the instant claimed particle size for Mg-silicate <pigment> would be obvious over the prior art film thickness of 3-8 micron.

With regard to claim 173, the prior art component range overlaps with the instant claimed range and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

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is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 141-145, 149, 153, 171 and 173 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-35, 38, 40, 46, 47, 50, 56, 69-70 of copending Application No. 10/511242. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and copending application are drawn to similar compositions having similar components and same utility as conductive coatings, while the instant claims contain specific ranges of components and differ from the copending claims that do not have the ranges, and it would be obvious to a person of ordinary skilled in the art to optimize the composition for coating applications because they are well known in the art (See Wiechelhaus et al (WO 99/24545).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant's arguments filed 08/14/2008 have been fully considered but they are not persuasive. Applicants argument that Leon (US 3,562,124) and Reising (US 6,715,196) fail to teach Sn or Sn alloys as pigment/filler in the corrosion resistant/weldable coatings is correct (Res, Pg-8, Last Para).

In response to the argument that Tsuneta (5,213,846) teaches the problems associated with metallic powders and prefers graphite in the coatings of Tsuneta; the prior art clearly teaches that Zn Al, Sn etc metals have been used to conductivity and weldability and a person of ordinary skilled in the art would have included the metals of Tsuneta in the corrosion resistant coating compositions of Leon based on metals and their alloys; and A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). The Use of Sn with Zn in weldable/corrosion resistant coatings is well known in the art (See Geeck et al; Title, Cl-2, Ln 30-32, 56-60).

In response to Matsuda et al (US3,904,555) teach Al paste and Zn powder or Pb together with Fe powder in the examples, teaches Zn powder as soft powder and no indication of how Sn or Sn alloy would behave, the prior art clearly teaches Sn and its alloys in a short group of metal/alloy fillers and a person of ordinary skilled in the art would have included the metals of Matsuda in the corrosion resistant coating compositions of Leon based on metals and their alloys; and A reference may be relied upon for all that it would have reasonably suggested to one

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having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). The Use of Sn with Zn in weldable/corrosion resistant coatings is well known in the art (See Geeck et al; Title, Cl-2, Ln 30-32, 56-60).

For the reasons set forth above applicants fail to patentably distinguish their composition over prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to KALLAMBELLA VIJAYAKUMAR whose telephone number is (571)272-1324. The examiner can normally be reached on M-F 07-3.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 5712721358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/KMV/  
November 22, 2008.

/Stuart Hendrickson/  
Primary Examiner, Art Unit 1793